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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,487	09/26/2003	Yoav Weizman	SC0969EI	8248
23125	7590	03/16/2006	EXAMINER	
FREESCALE SEMICONDUCTOR, INC. LAW DEPARTMENT 7700 WEST PARMER LANE MD:TX32/PL02 AUSTIN, TX 78729			VAZQUEZ, ARLEEN M	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,487

Applicant(s)

WEIZMAN ET AL. 

Examiner

Arleen M. Vazquez

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/26/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4 and 6-10, drawn to an integrated circuit, classified in class 324, subclass 763.
 - II. Claim 5, drawn to method for testing integrated circuit functionality, classified in class 716, subclass 4.

2. Inventions *I.* and *II.* are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h).

In the instant case the integrated circuit of invention of Group *I.* does not required a method step of designing circuit function modules as required for invention of Group *II.*

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Daniel D. Hill on March 2, 2006 a provisional election was made without traverse to prosecute the invention of Group *I.*, claims 1-4 and 6-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 5 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention of Group *II.*, there being no allowable generic or linking claim. Election was made **without** traverse in the phone interview on March 2, 2006.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the calibration structure, probing structure and optical alignment means must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

Art Unit: 2829

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claims 6-8 are objected to because of the following informalities:

As to claims 6-8, the limitations of "calibration structure, probing structure and optical alignment means" are not clear identified. Are these limitations shown in the drawings?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2829

10. Claims 1-4 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by **Dukes et al. (US 5,570,035)**.

As to claim 1, **Dukes et al.** discloses in Figure 2 an analysis module for incorporation in an integrated circuit (32), the integrated circuit (32) having circuit function modules (34,36,38,40), the analysis module including at least one submodule test structure (50) arranged such that analysis of the at least one submodule test structure (50) provides at least one physical parameter of the integrated circuit (32) for use in subsequent testing of the circuit function modules (Col. 3 lines 5-8).

As to claim 2, **Dukes et al.** discloses in Figure 2 an integrated circuit (32) comprising circuit function modules (34,36,38,40) arranged to provide operating functions of the integrated circuit (32), and an analysis module including at least one submodule test structure (50) arranged such that analysis of the at least one submodule test structure (50) provides at least one physical parameter of the integrated circuit (32) for use in subsequent testing of the circuit function modules (Col. 3 lines 5-8).

As to claim 3, **Dukes et al.** discloses in Figure 2 a system comprising at least one analysis tool (26), an integrated circuit (32) having circuit function modules (34,36,38,40) arranged to provide operating functions of the integrated circuit (32), and an analysis module including at least one submodule test structure (50), wherein the at least one submodule test structure (50) is arranged such that analysis of the at least one submodule test structure (50) by the at least one analysis tool (26) provides at least one physical parameter of the integrated circuit (32) for use in subsequent testing of the circuit function modules (Col. 3 lines 5-8) by at least one analysis tool.

Art Unit: 2829

As to claim 4, **Dukes et al.** discloses in Figure 2 the at least one submodule test structure (50) is chosen in dependence upon the at least one analysis tool (26) to be used in subsequent testing.

As to claim 9, **Dukes et al.** discloses in Figure 2 the at least one submodule test structure (50) is isolated from the function modules (34,36,38,40).

As to claim 10, **Dukes et al.** discloses in Figure 2 the testing includes failure analysis, system calibration and evaluation (Col. 3 lines 10-15).

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rohrbaugh et al. (Us 6,556,938) discloses "Systems And Methods For Facilitating Automated Test Equipment Functionality Within Integrated Circuits".

Eldridge et al. (US 6,603,324) discloses a "Special Contact Points For Accessing Internal Circuitry Of An Integrated Circuit".


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arleen M. Vazquez whose telephone number is 571-272-2619. The examiner can normally be reached on Monday to Friday, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on 571-272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2829

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMV


VINH NGUYEN
PRIMARY EXAMINER
A-11.2829
03/13/06